

Remarks

Claims 95-167 are pending in the subject application. Applicants acknowledge that claims 98-102, 104-119, 122, 123, 125, 126, and 133-141 have been withdrawn from further consideration as being drawn to a non-elected invention. By this Amendment, Applicants have canceled claims 103, 105-107, 109-111, 113-115, 117-119, 133-137, 139-146, 148-150, and 152-167, amended claims 95, 104, 108, 112, 116, 120, 125-132, and 138 and added new claims 168-397. Support for the amendments and new claims can be found throughout the subject specification and in the claims as originally filed. Entry and consideration of the amendments presented herein is respectfully requested. Accordingly, claims 95-102, 104, 108, 112, 116, 120-132, 138, 147, 151 and 168-397 are currently before the Examiner (with claims 95-97, 120-121, 124-132, 147, 151, 168-241, 245-249, 251-290, 293, 299-338, 341, 347-386, 389, 395-397 reading on the elected invention and claims 98-102, 104, 108, 112, 116, 122, 123, 138, 242-244, 246-250, 291, 292, 294-298, 339-340, 342-346, 387 and 388-394 standing withdrawn from consideration). Favorable consideration of the pending claims is respectfully requested.

Applicants also wish to draw the Examiner's attention a continuation application (U.S. Patent Application Serial No. 11/841,886, filed August 20, 2007) claiming the benefit of the subject application. Applicants note that examination has not, as of this date, begun and that claims to any method claims pending in that application will be canceled in the near future.

As an initial matter, Applicants gratefully acknowledge the Examiner's indication that claims 147, 150, 151, 156, and 160 are objected to but would be allowable if rewritten into independent form to include the limitations of any base and intervening claims.

Claims 142, 146, 152-155, and 164-167 are rejected under 35 U.S.C. § 112, first paragraph, as nonenabled. The Office Action indicates that the specification is enabled for treating a mammal having diabetes but is not enabled for preventing a mammal for acquiring diabetes. Applicants respectfully assert that the claims as filed are enabled; however, in the interests of expediting prosecution in this matter the claims have been amended to delete reference to "preventing" or canceled. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, first paragraph, is respectfully requested as this issue is now moot.

Claims 103, 120, 121, 124, 148, 149, 153-155, 157, 158, 161, 162, 165, and 166 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite because the variable “M” has not been defined in the claims. Applicants respectfully assert that the claims as filed are definite as the pending claims now contain a definition of the variable “M”. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph, is respectfully requested.

Claims 95-97, 103, 120, 121, 124, 127-132, 142-146, 148, 149, 153-155, 157-159, 161-163, and 165-167 are rejected under 35 U.S.C. § 103(a) as obvious over Sahoo *et al.* (U.S. Patent No 6,008,237) in combination with Dang *et al.* (U.S. Patent No. 6,284,748). The Office Action states that the Sahoo *et al.* patent teaches a method for the treatment, control, or prevention of diabetes, hyperglycemia, hyperlipidemia, atherosclerosis, obesity, vascular restenosis, and other PPAR-mediated diseases, disorders and conditions employing compounds of Formula 1. Dang *et al.* teach purine compounds of Formula 1 that are inhibitors of FBPase at the AMP site. Applicants respectfully assert that the claimed invention is not obvious over the cited references. Particularly, the teachings of Dang *et al.* are not prior art to the instant application as the can be disqualified under 35 U.S.C. § 103(c) as prior art. In response to this rejection, Applicants respectfully submit that this application and the cited patent were commonly owned at the time this invention was made and that the patents are not prior art to the instantly claimed invention. A statement to this effect accompanies this response. Accordingly, reconsideration and withdrawal of both obviousness rejections is respectfully requested. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) is respectfully requested.

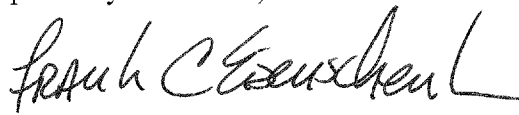
It should be understood that the amendments presented herein have been made solely to expedite prosecution of the subject application to completion and should not be construed as an indication of Applicants’ agreement with or acquiescence in the Examiner’s position. Applicants expressly reserve the right to pursue the invention(s) disclosed in the subject application, including any subject matter canceled or not pursued during prosecution of the subject application, in a related application.

In view of the foregoing remarks and amendments to the claims, Applicants believe that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 CFR §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

Applicants invite the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephonic interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



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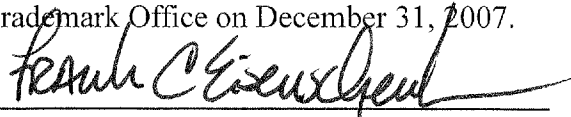
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Attachment: Statement Establishing Common Ownership or an Obligation of Assignment to the
Same Person, as Required by 35 U.S.C. 103(c)

I hereby certify that this correspondence is being electronically filed in the United States Patent and Trademark Office on December 31, 2007.

Patent Application
Docket No. MET-016XDT


Frank C. Eisenschenk, Ph.D., Patent Attorney

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Examiner : Patrick T. Lewis, Ph.D.
Art Unit : 1623
Applicants : Mark D. Erion, Paul D. van Poelje
Serial No. : 10/780,948
Filed : February 17, 2004
Conf. No. : 2285
For : Combination of FBPase Inhibitors and Insulin Sensitizers for the Treatment of Diabetes

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

STATEMENT ESTABLISHING COMMON OWNERSHIP OR
AN OBLIGATION OF ASSIGNMENT TO THE SAME PERSON,
AS REQUIRED BY 35 U.S.C. 103(c)

Sir:

Applications and references (whether patents, patent applications, patent application publications, *etc.*) will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person. In this instance, the cited U.S. Patent No. 6,284,748 and the above-identified patent

application were subject to an obligation of assignment to the same entity (Metabasis Therapeutics, Inc.) at the time the invention was made.

Respectfully submitted,

A handwritten signature in black ink, reading "Frank C. Eisenschenk". The signature is written in a cursive, flowing style.

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